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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional): 40062.0177US01

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on August 13, 2007

Signature Tricia Van Hooser

Typed or printed name Tricia Van Hooser

Application Number	Filed
09/598,856	06-21-2000

First Named Inventor: Erik Rucker

Art Unit	Examiner
2176	Singh, Rachna

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

No fees are believed due with this Pre-Appeal Brief Request for Review; however, please charge any necessary fees or credit any overpayment to Deposit Account No. 13-2725.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- ☑ attorney or agent of record. Registration number 36,408.
- ☐ attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____

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8/13/07
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

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This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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PRE-APPEAL BRIEF REQUEST FOR REVIEW
SUPPORTING STATEMENT

I. Background

In a March 21, 2007 Office Action ("March OA"), claims 1 and 5 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Brown et al. (USPN 6,067,551) ("Brown") in view of Miller et al. (US 2005/0055306) ("Miller"), and claims 13 and 21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Brown in view of Pham et al., US 6,560,719 ("Pham"). [1]

During prosecution of this application, Applicants have filed six amendments and engaged the Examiner in several interviews, including an in-person interview, but the Examiner has maintained substantially the same rejections throughout. Applicants accordingly filed a Notice of Appeal herewith. Nevertheless, Applicants believe the Examiner has failed to state a *prima facie* case for rejecting the independent claims, and all rejections should be withdrawn and the application allowed in its current form.

II. The Cited Brown Reference Does Not, Alone or In Combination with Other References, Make the Currently Amended Claims Obvious.

All of the pending independent claims have been rejected under 35 U.S.C. § 103 as being unpatentable over Brown in light of at least one additional reference. As discussed at length on pages 9-10 of Applicants' December 19, 2006, Amendment and Response, Brown teaches a method of controlling multi-user editing of a master copy of a document using a multi-user control file (MCF). The MCF provides access for remote users to a local copy of the master copy on the file server. The MCF controls save operations from various remote users' local copies to a master copy resident on the file server.

Brown does not, however, disclose "determining whether the original document is open at a second user, wherein the second user has exclusive rights to save the original document while the original document is open at the second user" as required by claim 1 (similar requirements exist in all other independent claims 5, 13, and 21 as well). Nor does Brown disclose taking any actions "in response to a determination that the original document is open at"

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[1] For the purposes of this brief, Applicants concentrate their comments on the pending independent claims: 1, 5, 13, and 21. In addition, Applicants address herein only certain distinctions between the claims and the cited art; however, nothing herein is intended to limit the scope or content of Applicants' arguments on appeal, if necessary.

another user as required in various elements of each independent claim. *See* claims 1, 5, 13, and 21. Whether the original document is "open" at a second user is irrelevant in Brown. Every user, regardless of whether it is the first to seek access to the document at issue, receives only a local copy. No user has exclusive saving rights.

The Examiner attempts to use a variety of disconnected elements and allusions from Brown to meet the limitations in claim 1 related to a determination that the original document being "open." First, the Examiner argues vaguely that the "recognizing multiple-user editing of the document" meets the claim 1 limitation "determining whether the original document is open at a second user." *See* March OA, p. 3. The Examiner refers to only the summary of the invention and claim 1 of Brown for this proposition – no specific language in Brown is cited. Indeed, the word "recognizing" is not used in Brown.

The Examiner separately argues that Brown teaches "determining whether the original document is open at a second user" by citing Brown at Col. 10 & 11 under the heading "The Multi-User Program Module." *See* March OA, p. 24. The cited sections simply recognize that sometimes only one user at a time will be editing a document. The Examiner concludes from these sections: "In other words, Brown teaches that a user can use the master copy (i.e., original document) for which a MCF (multi-user control file) exists to save edits." *See* March OA, p. 24. This argument is a *non sequitur*. The MCF is created regardless of whether another user already has the document open. *See* Brown Figures 2A, 2B, and 2D (If the MCF does not exist (220), the MCF is created (221), and a local copy is created (250) and edited by the user (255)). There is no difference in this procedure whether the document is, or is not, already open at another user. If only one user is editing the document, the MCF will be created but not have any effect. There is no teaching in Brown to determine whether the document is open at another user, and no action in Brown is dependent on such a determination.

Next, the Examiner changes tack and equates "determining whether the original document is open" to the determination in Brown of whether another user is currently saving edits from its local copy to the master copy (i.e., by checking whether the MCF is locked). *See* March OA, p. 24 ("Brown teaches that if user is the first to access a master copy then the MCF is created and locked when the first user is making a save operation, all other users are denied access to the MCF.").

First, determining whether the MCF is locked because a save operation is occurring is not, under any reasonable interpretation, the same as determining whether the document is currently open at another user. Moreover, the determination of whether the MCF is locked in Brown simply does not map to the use of the "open" determination in the claims. For example, Claim 1 requires "in response to a determination that the original document is open at the second user, creating a local copy and storing a path of the original document with the local copy." The Examiner argues that this element is met by Brown creating a local copy for each user. *See* March OA, pp. 3-4. The Examiner has presented no argument, however, that the local copy is created "in response to a determination that the original document is open at the second user." In fact, if even accepting the Examiner's faulty correlation of the original document being "open" to the MCF being "locked," Brown teaches directly away from the required element. In Brown, if the MCF is locked (*See* Figure 2A, reference 235), the user waits until it is unlocked before the master copy is accessed (230) and the local copy is created (250), which is akin (according to the Examiner's analogy) to the document no longer being open at another user. This is the exact opposite of what claim 1 requires. The deficiencies in the Examiner's claim 1 arguments with regard to Brown are also fatal to the rejections of the other independent claims.[2]

III. The Cited Miller Reference Does Not Make up for the Deficiencies in Brown and is not Combinable with Brown.

The Examiner cites Miller with respect to claims 1 and 5. Miller discloses a system for checking documents in and out of a file server. *See* Miller paras. 0175-0177. Although a user in the Miller system may need to determine whether a particular document has been "checked out" by another user, Miller does not disclose any way for multiple users to simultaneously edit a document or to merge local copy changes back into an original document. If a user checks a particular document out, no other user may modify it. *See* Miller para. 0181.

With respect to claim 1, the Examiner cites Miller for the step of "in response to a determination that the original document is still open at the second user, prompting the first user to decide between saving the local copy with the path of the original document such that a

[2] Claims 5, 13, and 21 include similar amendments relating to creating a local copy in response to a determination whether the original document is "open" at another user (*See*, without limitation, claim 5: "in response to a determination that the original document is open at a second user, creating and storing a local copy and storing a path of the original document with the local copy"; claim 13: "in response to a determination that the flag is set, the second local document editor is further operative to create a local copy of the original document"; claim 21, currently amended: "in response to a determination that the original document is open at the second user, creating a local document file and storing a path of the original document file as part of the local document file.")

subsequent merge of the saved local copy and the original document can be performed, and saving the local copy as a separate file as compared to the original document." *See* March OA, pp. 6 & 25, citing Miller at paragraphs [0166]-[0173] and [0175]-[0177]. The cited sections of Miller simply do not disclose what the Examiner states they do. Rather, they confirm that although a modified file can be saved as a new file or different version of a current one, "a file in the repository can only be replaced if the user has checked it out." *See* Miller, para. [0169]. There is absolutely no disclosure in the cited sections or elsewhere in Miller of "prompting" the user in the way claimed. Nor is there any discussion of how changes made by a user who did not check the file out (i.e., files saved as separate files or new versions) can be merged back into the original document (e.g., the document in the repository). Miller is a basic check-in, check-out system – it allows one user at a time to edit a document and it is simply unconcerned with merging edits from multiple users back into a single document. Miller does not teach prompting the user to do anything in response to a determination that the original document is still open.

The Examiner also cites Miller in relation to claim 5. The Examiner first asserts that Miller teaches "prompting the user to decide whether to merge changes made to the local copy into the original document." As discussed above, Miller does not disclose any prompting of the user to decide whether to merge local-copy changes into the original document. In fact, there is no discussion in Miller of how local copy changes are ever merged back into an original document, let alone prompting the user to decide whether to do so. Moreover, the Examiner asserts, without explanation, that Miller teaches "monitoring the original document by periodically determining whether the original document is still open at the second user." (See March OA, pp. 8-9.) That is simply untrue. Miller has no discussion whatsoever of monitoring whether a document is no longer open at another user, and the Examiner has not cited any section of Miller that indicates otherwise.

Nor, contrary to the suggestion by the Examiner, is there any motivation to combine Miller with Brown. Even in the recent decision in *KSR Int'l Co. v. Teleflex, Inc.*, the Supreme Court reaffirmed that it is "important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements." *See* May 3, 2007 Memorandum from Deputy Commissioner Focarino, p. 2. Miller teaches away from Brown. Brown is directed to a system wherein a plurality of users can all edit a document at the same time, and a central-server process controls the versions and ensures saves of edits from various

local copies are effectively managed. Miller, on the other hand, prohibits edits by anyone except the user that has a document checked out. All other users must wait until after it has been checked back in to check the document out themselves and make any changes. Simply put, Miller is designed specifically to prohibit multiple versions of a document being propagated and later merged, whereas Brown encourages multiple versions of a document to be created and merged by managing a sophisticated central server process. To imply that the combination of Brown and Miller would have been obvious to one of skill in the art to meet the elements of the claims as presently amended could only be rendered from the use of impermissible hindsight gleaned from the benefits of the present application. *See, Ex parte Haymond*, 41 USPQ2d 1217, 1220 (Bd. Pat. App. & Int. 1996).

IV. The Cited Pham Reference Does Not Make up for the Deficiencies in Brown.

The Examiner argues that Pham is combinable with Brown to meet both the claim 13 limitation: "in response to a determination that the flag is set, . . . to create a local copy of the original document and to store the document location with the local copy as a registry key associated with the local copy"; and the claim 21 limitation: "in response to a determination that the original document file is still open at the second user, saving the local document file with the path of the original document file as a registry key associated with the local copy." The Examiner is, again, mistaken.

Pham discloses a method for recovery of original registry key file data. Pham has nothing to do with multi-user editing systems, and the Examiner cites Pham solely because Pham discusses the use of registry keys. There is no reason for one of ordinary skill to combine Pham with Brown. In addition, Pham does not make up for the substantive deficiencies in Brown. For example, as discussed, no action in Brown is dependent upon a determination that the original document is still open elsewhere (or that a flag is set indicating that the document is still open). In fact, according to the Examiner's own analogy that the MCF "lock" setting correlates to the "open" determination in claims 13 and 21, Brown teaches directly away from the quoted claim elements by creating a local copy only after the MCF is unlocked (see above). The Examiner has not, and cannot, point to any support in Pham to make up for this deficiency in Brown.

V. Conclusion

For at least the reasons set forth herein, Applicants respectfully request that the present application be withdrawn from appeal an allowed in its current form.